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Paper No. 5

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In re Application of
William B. Chapman, Timothy Day, John Pease,
and Paul Zorbedian
Application No. 09/848,914
Filed: May 4, 2001
Attorney Docket No. NUFO-028
Title: METHOD AND APPARATUS FOR
TUNING A LASER

COPY MAILED

OCT 10 2001

OFFICE OF PETITIONS

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed September 4, 2001.

The petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on may 4, 2001, without an executed oath or declaration and identifying William B. Chapman, Timothy Day, John Pease, and Paul Zorbedian as joint inventors. Accordingly, on June 28, 2001, a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" was mailed, requiring an executed oath or declaration in compliance with §1.63 and a surcharge for its late filing. This Notice set a two-month period for reply.

In reply, applicant filed the instant petition (and fee) and paid the surcharge for late filing of the declaration². Accompanying the petition was the non-signing inventor's employment agreement with his employer, New Focus, inc. (New Focus), a declaration executed by Joseph T. Fitzgerald

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventor;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he cannot be found, and;
- (6) a declaration which complies with 37 CFR 1.63.

²The petition contained a certificate of mailing dated August 28, 2001.

(the Director of Intellectual Property for New Focus), a declaration executed by Mark E. Kelly (the Intellectual Property Manager of New Focus), and a letter from the petitioner to the non-signing inventor..

The petitioner's statement, as well as the declarations of Mr. Fitzgerald and Ms. Kelly, establishes that the non-signing inventor was an employee of New Focus at the time of invention, but left prior to the filing of this application. A copy of his employment agreement has been submitted as proof of his contractual obligation to assign all inventions to his employer. Prior to filing, Mr. Fitzgerald telephoned and e-mailed the non-signing inventor to attempt to secure his signature on the declaration. On July 25, 2001, Mr. Fitzgerald spoke with the non-signing inventor via telephone, in the presence of Ms. Kelly. Mr. Fitzgerald requested that the non-signing inventor review the application and sign the declaration. Mr. Zorabedian replied that he would comply with the request only after having been presented with a \$100,000 check from New Focus, a request which was balked at by Mr. Fitzgerald. Mr. Hall then sent a letter to the non-signing inventor, reiterating New Focus' belief that this request was unreasonable, and offering to provide "reasonable compensation...the rate you were compensated as a new Focus employee" to stop by the New Focus facility to review the application and sign the declaration.

Rule 47 applicant has met requirements (1), (2), and (6) above.

Regarding requirement (3) above, no statement of the last known address of the non-signing inventor has been submitted.

Regarding requirements (4) and (5), it is determined that the Rule 47 applicant has failed to show that the non-signing inventors refused to sign the declaration after having been presented with the application papers. Before a refusal can be alleged, applicant must demonstrate that a *bona fide* attempt was made to present a copy of the application papers to each non-signing inventor. See MPEP 409.03(d). It has not been set forth that the non-signing inventor was ever presented with the complete application papers. Nowhere is it set forth that a copy of the entire application was sent to the non-signing inventor. It appears that New Focus intended to have Mr. Zorabedian visit the business facility, review the application, and sign the declaration. The agents of New Focus telephoned, e-mailed, and wrote to Mr. Zorabedian in an attempt to secure this visitation. After the failure of their plurality of solicitations, the present petition was filed. The submitted evidence leads this Petitions Attorney to conclude that no copy of the application was ever presented to the non-signing inventor for his review. It follows that one cannot refuse to sign a declaration which one has not been presented with.

Thus, on renewed petition, applicant must submit the last known address of the non-signing inventor, and establish that the entire application package, including the specification and the claims was presented to the non-signing inventor and he refused to sign a copy of the declaration. A copy of the application papers should be sent by certified mail return-receipt requested to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.



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